

Remarks

Rejections under 35 U.S.C. 103

In the office action dated 05/11/2010, claims 1, 2, 5-7, 9 and 11 stand rejected as being unpatentable over Candau (US 6,033,648).

Claims 1, 2, 5-7, 11 and 12 stand rejected as being unpatentable over Lemann et al. (US 6,541,017).

Applicant respectfully submits the 103 rejections in the 9/01/2009 office action, and as maintained in the 05/11/2010 final rejection, to be improper for the reasons as detailed in Applicant's 1/29/2010 response (and as summarized in the 05/11/2010 office action under the headings Applicant's Arguments). Applicant respectfully submits the 103 rejections based on Candau and Lemann fail to establish a *prima facie* case of obviousness.

In both rejections, the office action cites In re Peterson, 65 USPQ2d 1379, 1382 (Fed. Cir. 2003) as precedent for overlapping ranges to establish *prima facie* obviousness. Applicant does not believe the present claims involve "overlapping ranges" in the same manner as In re Peterson. Applicant believes In re Peterson was concerned with ranges of elements or components in a composition, as discussed in **MPEP 2144.05 Obviousness of Ranges [R-5]**.

The present claims are drawn to a composition comprising a hydrocarbyl functional organopolysiloxane. The hydrocarbyl group is defined as R¹ having the formula $-(CH_2)_nOCH_2CH_2OH$. The Candau and Lemann references disclose silicone polyether or silicone oxyalkylene substituted silicones where in all cases the oxyalkylene groups are described as being selected from a combination of EO (-CH₂CH₂O-) and PO (-C₃H₆O-) units. Applicant respectfully submits Candau and Lemann at best disclose a chemical formula that represents a genus of the present hydrocarbyl functional

organopolysiloxanes. As such, Applicant believes the guidelines established in **MPEP 2144.08** for assessing obviousness of genus/sub-genus/species relationships should apply in the present application. Applicant submits that the 09/01/2009 103 rejections, and as maintained in the 05/11/2010 final rejection, fail to follow the **MPEP 2144.08** guidelines for assessing obviousness of genus/sub-genus/species relationships.

In the 05/11/2010 final rejection, the Examiner acknowledges that In re Peterson “relates to overlapping ranges in a different manner”, and further seems to acknowledge the formula of the instant claim and the cited references may be interpreted to encompass various species (second paragraph, page 5, as reproduced below; and last paragraph page 7 to top of page 8).

Although In re Peterson relates to overlapping ranges in a different manner, the instant case correlates to the decision insofar as the variables of the reference and the instant claims show some overlap and thus some of the species encompassed by the formula of the reference is also encompassed by the formula of the instant claims.

Applicant’s believe the Examiner applies In re Peterson incorrectly in the instant case. Applicant respectfully submits “the variables of the reference, and the instant claims” are ranges within a chemical formula that are used to define a genus/sub-genus/species relationship which Applicant believes is completely different from defining a range of elements or components as discussed in In re Peterson. As such, Applicant believes the guidelines established in **MPEP 2144.08** for assessing obviousness of genus/sub-genus/species relationships should apply in the present application.

Applicant respectfully submits that the 103 rejections fail to specifically describe why one skilled in the art, upon reading Candau or Lemann, would be motivated to select the presently claimed siloxanes having the defined R¹ hydrocarbyl group, from the large number of possible formula or options taught by Candau or Lemann. Lacking such motivation, Applicant respectfully submits the 103 rejections fail to establish a *prima facie* case of obviousness.

The present response is being submitted within the three-month statutory period for response to the outstanding Office Action. Applicant authorizes the USPTO to charge deposit account 04-1520 for any fees that should be necessary to maintain the pendency of the application.

In view of the above, it is respectfully submitted that the claims are in condition for allowance. Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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